IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No 05-940-F (EX03-057C-US))

In the Application of:	)	
	)	
Francis-Lang *et al.*	)	
	)	**Examiner: Swope, Sheridan**
Serial No.: 10/523,588	)	
	)	**Group Art Unit: 1652**
Filing Date: February 4, 2005	)	
	)	**Confirmation No. 4379**
For: CSNK1Gs as Modifiers of the p21 Pathway and Methods of Use	)	

RESPONSE TO SPECIES RESTRICTION REQUIRMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the restriction requirement mailed on August 9, 2010 in the above-mentioned application. It is believed that no fee is due in connection with this filing. However, if a fee is due the Commissioner is authorized to charge our deposit account 13-2490.

The Office alleged that, based on amendment, claims 1, 3, and 16 encompass patentably distinct species of the generic invention because the different species recite mutually exclusive characteristics of the species and the species are not obvious variants of each other.

With respect to the species restriction requirement, Applicant hereby elects with traverse the assay of claim 1 for prosecution on the merits. The claims readable thereon are claims 1, 3, 16, and 27-29. The Office stated that claims 1, 3, 16, and 27-29 are generic. Upon allowance of a generic claim, Applicant is entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim.

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In addition, the Office stated that the Applicants are required to make a species election with respect to the sequence of the casein kinase I gamma used in the claimed methods. With respect to the species restriction requirement, Applicant hereby elects with traverse SEQ ID NO: 11 for prosecution on the merits. The claims readable thereon are claims 1, 3, 16, and 27-29. The restriction requirement is traversed for the reasons set forth below.

Applicants respectfully request that the Examiner reconsider the species restriction requirement and examine SEQ ID NOs: 10-12. MPEP § 808.01(a) states that a requirement for a species restriction is only proper if both the following criteria are met: (1) the purported inventions must be patentably distinct or independent, **and** (2) there must be a serious burden on the Examiner if the restriction were not required.

Initially, Applicants submit that the Examiner has not established a *prima facie* case demonstrating the requirement for the species restriction. Even if the species of SEQ ID NOs. 10-12 are distinct, the Examiner, in order to establish reasons for insisting on the species restriction, must explain why there would be a serious burden on the Examiner if the restriction is not required. MPEP §§ 808.01(a) and 808.02. Accordingly, the Examiner must show by appropriate explanation, one of the following: separate classification, status in the art, or field of search.

In this case, the Examiner merely asserts that that there would be a serious burden if restriction were not required for one of three generic reasons (the species require a different field of search, and/or the prior art applicable to one species would not likely be applicable to another species, and/or the species are likely to raise different non-prior art issues), but fails to specify which reason(s) would cause the undue burden and how or why such burden would be imposed. Applicants submit that such an unsupported assertion is not the appropriate explanation required by the rules. For example, the Examiner does not specify or provide any examples for the different fields of search that allegedly would be required. MPEP § 808.02. Accordingly, the Office fails to establish undue burden as required under MPEP 808.02.

Further, Applicants respectfully disagree that there would be a serious search and examination burden if the restriction were not required. The sequences of SEQ ID NOs:

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10-12 encode species of the same casein kinase 1, gamma 3 protein. The encoded proteins each have the same amino acid sequence, with the exception that SEQ ID NO: 10 has an eight amino acid deletion and a one amino acid substitution in comparison with SEQ ID NO: 11 and SEQ ID NO: 12 has a 32 amino acid deletion in comparison with SEQ ID NOs: 10 and 11. Although the Examiner does indicate the class/subclass of the search, given that the nucleotide sequences encode the same protein with minor sequence differences, it is unlikely that the claimed methods comprising any of SEQ ID NOs: 10-12 would be found in a separate classification, would have a separate status in the art, and that the search would involve a different field of search (e.g., would involve searching different classes/subclasses or employing different search queries). MPEP § 808.02. Accordingly, because there would not be a serious burden on the Examiner if the species restriction is not required, Applicant believes the restriction is improper and respectfully requests withdrawal of the species restriction requirement with respect to SEQ ID NOs: 10-12.

The Office stated that claims 1, 3, 16, and 27-29 are generic. Upon allowance of a generic claim, Applicant is entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim.

If the Examiner has any questions regarding this response, he is invited to call the undersigned attorney.

Respectfully submitted,

Dated: September 9, 2010

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